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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,391	07/23/2003	Ronald G. Dusterhoft	980306UIRI	7884

7590

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EXAMINER

KRECK, JOHN J

ART UNIT	PAPER NUMBER
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3673

DATE MAILED: 03/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/625,391

Applicant(s)

DUSTERHOFT ET AL.

Examiner

John Kreck

Art Unit

3673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-21 is/are allowed.
- 6) ☒ Claim(s) 22-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3 pages
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

The amendment dated 12/27/2005 has been entered.

Claims 1-54 are pending.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Claims 22-54 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. See 37 CFR 1.175.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

Claim Rejections

1. Claims 22-26, 28-44, and 46-54 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Regarding apparatus claims 22-26:

Each independent apparatus claim in the patent calls for the screen to be pleated, however this limitation is not found in claims 22-26. In prosecution of the application; the circumferentially pleated aspect of these claims was specifically argued. See pages 5 and 6 of applicant's response filed 12/6/2000.

Regarding process claims 28-44, and 46-54:

Each independent process claim in the patent calls for the screen to be circumferentially pleated, however this limitation is not found in claims 28-44, and 46-54. In prosecution of the application; the circumferentially pleated aspect of these claims was specifically argued. See page 6, last paragraph of applicant's response filed 12/6/2000; and page 5, paragraphs 4-6 of applicant's response filed 2/2/2001.

This is a clear indication that the broadening of claims 28-44, and 46-54, by omission of "circumferentially pleated", is an improper recapture of subject matter surrendered in the application for the patent upon which the present reissue is based.

Claims 27 and 45 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

2. Applicant's arguments filed 10/5/05 have been fully considered but they are not persuasive. Applicant has argued that the "improper recapture" rejections should be withdrawn, since the subject matter at issue was allegedly not surrendered during prosecution of the application which led to U.S. Patent number 6,263,966. This is not persuasive, since several instances can be found where applicant specifically argued the "pleated" or "circumferentially pleated" limitations.

3. Swift teaches an expandable filter.

It is noted that during prosecution of 09/220,289; applicant asserted that "the structures 54 shown in FIG. 5 of Swift are not filtering structures, but are epoxy filled sealing structures..."; and patent owner now asserts that the arguments (which have been reproduced above) are drawn only to the alleged fact that Swift lacks a filter structure altogether. This assertion is not persuasive: Swift clearly discloses filtering, and clearly shows a filter (e.g. 32) in figure 5. See, e.g., column 5, lines 6-9 of Swift: "When liner 32 is expanded, the width of slots 52 should be small enough to prevent the entry of the smallest gravel particles into liner 32." This plainly shows that Swift teaches an expandable filter.

It is apparent that Examiner made in error in the rejection dated 9/12/2000; wherein element "54" was identified as a pleated woven filter in the text supporting the rejection of **dependent** claims 9, 10, 17, and 18. The numerous arguments made with regard to the **independent** claims (as reproduced below) make it clear that applicant was arguing the "pleated" feature of the claims.

4. During prosecution of 09/220,289; a rejection was made of various claims over Swift. See, e.g. page 2 of the detailed action dated 9/11/2000 "*Swift shows a subterranean well system comprising a wellbore intersecting a formation; and a well screen disposed within the wellbore including a radially expanded filter element as called for in claim 7.*"

In the reply dated 12/6/200, applicant amended claim 7 to include the language "woven metal material". Applicant answered the rejection with arguments including the following: (Page 6, lines 9-10 of response filed 12/6/2000)

"The Swift structure does not utilize an expandable pleated filter structure, let alone a pleated filter structure made of a woven metal material..."

It appears that the addition of "woven metal material" was superfluous, since Swift lacked the **pleated** feature, by applicant's own admission.

Claim 7 was subsequently allowed.

5. During prosecution, applicant submitted various other arguments specifically directed to the **pleated** feature:

Page 6, line 17 of response filed 12/6/2000:

"Claim 11 recites a pleated filter element, and claims 13 and 21-23 recite a pleated filter element of a woven filter material. As discussed above, Swift fails to disclose these claimed elements of the present applicants' invention."

Page 6, line 20 of response filed 12/6/2000:

"Claim 13 specifies a circumferentially pleated filter element expanded against gravel... Swift fails to disclose either a pleated filter element or the expansion thereof against gravel..."

Page 6, line 24 of response filed 12/6/2000:

“ Claims 15 and 16 recite a screen having a circumferentially pleated filter element, and the expansion of the screen to a radially enlarged configuration. Swift fails to meet these limitations since it clearly does not disclose a screen structure having a pleated filter element.”

The evidence is overwhelming that the “pleated” feature was specifically argued during prosecution, thus claims lacking that pleated feature constitute surrendered subject matter.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No.

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6,263,966 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

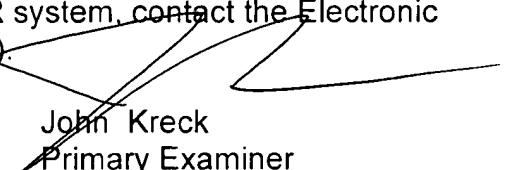
These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

Applicant is notified that any subsequent amendment to the specification and/or claims must comply with 37 CFR 1.173(b).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Kreck whose telephone number is 571-272-7042. The examiner can normally be reached on Mon- Th: 530-200; Fri: telework.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Engle can be reached on 571-272-6660. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John Kreck
Primary Examiner
Art Unit 3673

23 February 2006